UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte NORBERT BECKER, GEORG BIEHLER, MATTHIAS DIEZEL,
ALBRECHT DONNER, DIETER ECKARDT, HARALD HERBERTH,
MANFRED KRAMER, DIRK LANGKAFEL, RALF LEINS,
RONALD LANGE, WALTER MOLLER-NEHRING,
JURGEN SCHMOLL, KARSTEN SCHNEIDER, ULRICH WELZ,
and HELMOT WINDL

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Appeal 2008-2316
Application 09/936,047[1]
Technology Center 2100

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Decided: August 26, 2008

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Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 16. We have jurisdiction under 35 U.S.C. § 6(b). We reverse, and enter a new ground of rejection.

Appellants invented an automation system for creating in parallel and on a distributed basis an automation solution. (Spec. 2.) As depicted in Figure 1, the automation system includes a directory (V) for storing object names corresponding to a plurality of automation objects (O1..On), which are to be worked on. Each object name is assigned to a respective directory entry (OE), which includes a first information data (O11) referring to the corresponding automation object. The directory entry (OE) further includes a second information data (O12) describing the technological functionality of the automation object. The directory entry (OE) also includes a third information data describing an interface of the automation object. Additionally, the directory entry (OE) includes a fourth information data listing the names of the automation object subcomponents. (Spec. 3-4.) Upon creating a directory entry for the automation object, other users can immediately and concurrently access the entered object to further work on the automation object. (Id.)

Independent claim 1 further illustrates the invention. It reads as follows:

1. An automation system for creating an automation solution in automation technology, said system comprising:

a plurality of automation objects which are to be created and worked on, each automation object realizing a partial automation solution;

a directory for entering and storing object names of the automation objects when created;

directory entries assigned to the respective object names, each directory entry including first information data as a reference to the respective automation object, second information data as a description of technological functionality of the respective automation object and third information data as a description of an interface of the respective automation object,

wherein once entry into the directory has taken place, the respective automation object can be viewed by at least one of other users and tools, and

wherein the object name of the respective automation object can be used to request a reference to the respective automation object to be worked on by a number of users in parallel to create the automation solution in automation technology.

The Examiner relies on the following prior art:

Weinberg	US 5,974,572	Oct. 26, 1999
Bentley	US 5,987,242	Nov. 16, 1999

The Examiner rejects the claims on appeal as follows:

Claims 1 through 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weinberg and Bentley.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Weinberg

1.   Weinberg discloses a site manager program (Astra) that scans a website to create a graphical site map showing all the URLs of the website as well as the links between the URLs. (Col. 7, ll. 46-49.)

2.   As shown in Figures 1-3, Weinberg's site map (30) includes a parent node along with a plurality of children nodes, each node having a name, and representing the respective content object of the website and the corresponding URL. (Col. 8, ll. 25-35.)

3.   Weinberg discloses that upon a user zooming in on a node, annotations such as page title, filename begin to appear. Further, upon the user positioning a cursor over a node, Astra displays the address of the node. Additionally, upon the user double clicking on the node, Astra launches the client's web browser to retrieve the URL from the server. Additionally, the site map displays other links such as incoming links, sub links and outgoing links associated with the selected node. (Col. 10, ll. 1-12, col. 12, ll. 32-47.)

4.   Weinberg discloses that Astra includes an automatic update button (37) that allows the user to update an existing website map to reflect the changes made to the site map since the prior mapping. (Col. 10, ll. 25-42.)

5.   Weinberg further discloses that Astra allows users to monitor the website activities such as visitor activity levels on individual links and URLs to thereby study visitor behavior pattern thereon. (Col. 7, ll. 58-65.)

6.   As shown in Figure 8, Weinberg also discloses an object model that includes six classes of objects that are implemented as automation objects (Astra, Site Graph, Edges, Edge, Nodes, and Node) in the creation of the Website map. Each Site Graph object corresponds to a map of a Website, and includes information about the URLs and links on the Website. (Col. 19, ll. 1-21.)

Bentley

7.   Bentley discloses an object-oriented computerized modeling system that stores created objects in one or more repositories, logically grouped into projects that are managed as a single unit. The objects are stored in a database on a networked server to permit multiple users to concurrently access the project. (Col. 4, ll. 58-65.)

ANALYSIS

1. *New Grounds of Rejection*

Using our authority under 37 C.F.R. § 41.50(b), we reject claims 1 through 16 under 35 U.S.C. § 112, second paragraph.

Independent claims 1 and 9 recite in relevant part "a plurality of automation objects which are to be created and worked on, each automation object realizing a partial automation solution." The phrase "objects which are to be created and worked on" purports to a future act, which may or may not occur. After reviewing Appellants' Specification, we are unable to ascertain the scope of the cited phrase. Moreover, Appellants' representative acknowledged the indefinite nature of the independent claims on appeal during the oral hearing conducted on August 13, 2008. Therefore, we conclude that claims 1 and 9 are indefinite for failing to distinctively claim the subject matter which Appellants regard as their invention.

Claims 2 through 8 and 10 through 16 are rejected for fully incorporating the deficiencies of independent claims 1 and 9, by virtue of their dependency thereon.

2. *35 U.S.C. § 103*

As a consequence of the new ground of rejection above, we pro forma reverse the outstanding prior art rejection of claims 1 through 16 as being unpatentable over the combination of Weinberg and Bentley. The subject matter encompassed by the claims on appeal must be reasonably understood

without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not adequately reflect what the disclosed invention is. Note *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.); Note also *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

II. 37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
>
> (2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

III. SUMMARY

(1) We have entered a new rejection against claims 1 through 16 as being indefinite.

(2) We pro forma reverse the Examiner's decision rejecting claims 1 through 16 as being unpatentable over the combination of Weinberg and Bentley.

(3) Because of the new ground of rejection, our decision is not a final agency action.

DECISION

We reverse the Examiner's decision rejecting claims 1 through 16, and enter our own rejection against these claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>REVERSED</u>
<u>37 C.F.R. § 41.50(b)</u>

rwk

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